

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed March 8, 2006 ("Office Action"). At the time of the Office Action, Claims 1-39 were pending in the application. In the Office Action, the Examiner rejects Claims 1-6, 11-19, and 24-39; and objects to Claims 7-10 and 20-23. In order to advance prosecution, Applicants amend Claims 2-3, 7, 10, 15-16, 20, 23, 27-29, 33, and 36. Applicants do not admit that these amendments were necessitated by any art references or rejections of claims.

Applicants appreciate the Examiner's review of the Application. Although the Applicants do not necessarily agree with the indication of newly added matter or the effective filing dates of various claims as set forth by the Examiner, the Applicants will respond to the rejections as set forth by the Examiner while maintaining the opportunity to present specific arguments on those points in the future.

#### **Specification Objections**

The Examiner objects to the disclosure due to informalities. Applicants amend lines 12, 14, and 16 on page 5 accordingly.

#### **Claim Objections**

The Examiner objects to Claims 10, 23, and 36 due to various informalities. Applicants amend Claims 10, 23, and 36 accordingly.

#### **Section 101 Rejections**

The Examiner rejects Claims 27-29 under 35 U.S.C. § 101. Applicants traverse this rejection. In order to advance prosecution, however, Applicants amend Claim 27. Accordingly, Applicants respectfully request the Examiner to withdraw the § 101 rejections.

#### **Section 102 Rejections**

The Examiner rejects Claims 1, 14, and 27 under 35 U.S.C. 102(b) as being anticipated by EP 1 039 695 A1 issued to Brockmann et al. ("*Brockmann*"). Applicants traverse this rejection and respectfully request reconsideration and allowance of Claims 1, 14, and 27.

Claim 1 recites, in part, “a first wireline interface,” “a second wireline interface” and “a wireless interface.” At best, *Brockmann* teaches a single wireline interface and a single wireless interface. In particular, *Brockmann* states, “The figure further shows a computer 3, which is both a component of the wireless network 1 by means of a wireless connecting channel 8, and of the wired network 2 by means of a wired data connection channel 9. The wireless data connection channel 8 is connected to a first adapter 4 which is included on an interface card 10 according to the invention. This interface card 10 is incorporated in the computer 3 and has in addition a second adapter 5 to which the second data connection channel 9 is connected. The first or second adapter 4, 5 communicates with the computer 3 under the control of a microcontroller 6 which is part of the interface card 10.” (*Brockmann*, col. 3, ll. 15-27). Therefore, at best, “first adapter 4” may comprise a single wireless interface and “second adapter 5” may comprise a single wireline interface. However, Claim 1 recites both “a first wireline interface” and “a second wireline interface.” “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

In order to reject the “second wireline interface,” the Examiner relies on “second adapter 5.” In order to reject the “first wireline interface,” the Examiner relies on “means for interfacing computer 3 with interface card 10 in the Figure.” (Office Action, ¶9). However, the Examiner does not cite any portion of *Brockmann* to support this portion of the rejection. Indeed, there is nothing in *Brockmann* that identifies what couples the “computer 3” with the “interface card 10,” and certainly nothing that teaches, suggest, or discloses that it is a “wireline interface.”

Applicants remind the Examiner that with respect to anticipation under §102, the Court of Appeals for the Federal Circuit has consistently adhered to the basic principle that: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In addition, “The identical invention must be shown in as complete detail as is contained in the ... claim,” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added).

Therefore, if the Examiner continues to maintain this rejection, then Applicants specifically request that the Examiner identify a specific portion of *Brockmann* that identifies what couples the “computer 3” with the “interface card 10” and, more specifically, that this portion of *Brockmann* is a “wireline interface.” Applicants respectfully submit that *Brockmann* does not have such a teaching. Therefore, Applicants respectfully request reconsideration and allowance of Claim 1.

For reasons analogous to those discussed above with regard to Claim 1, Applicants respectfully request reconsideration and allowance of Claims 14 and 27.

### **Section 103 Rejections**

The Examiner rejects Claims 2, 3, 5, 6, 11, 12, 15, 16, 18, 19, 24, 25, 28, 29, 31, 32, 37, and 38 under 35 U.S.C. 103(a) as being unpatentable over *Brockmann* as applied to Claims 1, 14, and 27 above, and further in view of U.S. Patent Application Publication No. 2003/0142683 A1 issued to Lam et al. (“*Lam*”). For reasons set forth in detail below, Applicants respectfully request reconsideration and allowance of Claims 2, 3, 5, 6, 11, 12, 15, 16, 18, 19, 24, 25, 28, 29, 31, 32, 37, and 38.

The Examiner rejects Claims 4, 17, and 30 under 35 U.S.C. 103(a) as being unpatentable over *Brockmann* in view of *Lam* as applied to Claims 2, 3, 5, 6, 11, 12, 15, 16, 18, 19, 24, 25, 28, 29, 31, 32, 37, and 38 above, and further in view of U.S. Patent No. 6,363,085 issued to Samuels (“*Samuels*”) and U.S. Patent Application Publication No. 2003/0083013 issued to Mowery et al. (“*Mowery*”). For reasons set forth in detail below, Applicants respectfully request reconsideration and allowance of Claims 4, 17, and 30.

The Examiner rejects Claims 13, 26, and 39 under 35 U.S.C. 103(a) as being unpatentable over *Brockmann* in view of *Lam* as applied to Claims 2, 3, 5, 6, 11, 12, 15, 16, 18, 19, 24, 25, 28, 29, 31, 32, 37, and 38 above, and further in view of U.S. Patent Application Publication No. 2002/0159419 issued to Morris (“*Morris*”). For reasons set forth in detail below, Applicants respectfully request reconsideration and allowance of Claims 13, 26, and 39.

At the outset, Applicants respectfully submit that the Examiner withdraw the *Brockmann-Lam* combination as improper. Applicants submit that there is no basis in the prior art to combine *Brockmann* and *Lam*. To combine prior art in order to defeat an application under 35 U.S.C. § 103, “there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” (Manual of Patent Examining Procedure (MPEP) §2143). If a “proposed modification would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01. Also, if a “proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP §2143.01. Applicants respectfully submit that the modification of *Brockmann* by the teachings of *Lam*, as suggested by the Examiner, would both “change the principle of operation” of *Brockmann* and render *Brockmann* “unsatisfactory for its intended purpose.”

*Brockmann* states “[t]he invention relates to an interface card suitable for installation in a computer for obtaining a data connection channel with a network in which one or more other computers are incorporated.” (*Brockmann*; ¶ 0001). The purpose of the interface card is to connect the computer in which it is installed to one or more other computers within a wireless network or a wireline network. For example, *Brockmann* states, “[t]o this end the interface card according to the invention is characterized in that the card incorporates a combination of at least: a first adapter suitable for connecting to a wireless network; a second adapter suitable for connecting to a wired network; and a microcontroller which, depending on the data traffic present on the first or the second adapter, **services a circuit to provide the data connection channel between the first and the second adapter, respectively, and the computer in which the card is incorporated.**” (*Brockmann*; ¶ 0004; emphasis added). On the contrary, *Lam* teaches “a local area network router, that allows communication between a number of remotely located users, and a plurality of peripheral devices connected to the local area network router.” (*Lam*; Abstract).

The Examiner states that it would have been obvious to combine the “local area network router” of *Lam* in the system of *Brockmann* “for the advantage of allowing communication between a number of remotely located users, and a plurality of peripheral devices connected to said local area network router.” (Office Action, ¶ 12). Applicants traverse the Examiner’s position and submit that the modification of *Brockmann* by the teachings of *Lam* would destroy the operation of *Brockmann* because the computer 3 of *Brockman* could no longer communicate with the interface card 10 if the local area network

router of *Lam* were included, as suggested by the Examiner. In particular, if the local area network router of *Lam* were included in *Brockmann*, the communications would then be between the wired network computer 2 of *Brockmann* and the peripherals coupled to the local area network router of *Lam*, or between the wireless network computers 1 of *Brockmann* and the peripherals coupled to the local area network router of *Lam*, but **not** between the computers 1 or 2 of *Brockmann* and the computer 3 of *Brockmann*, which communication is the fundamental intended operation of *Brockmann*. The connection between interface card 10 and computer 3 of *Brockmann* would therefore be lost if *Brockmann* were combined with *Lam*, as suggested by the Examiner. Therefore, the modification of *Brockmann* by *Lam* would render inoperable a fundamental intended operation of *Brockmann* – to have computer 3 communicate with either computers 1 or 2. Such a modification would also completely change the principle of operation of *Brockmann* beyond anything that was contemplated by *Brockmann*. Moreover, such a combination is completely inconsistent with the position taken by the Examiner with respect to Claim 1 in which the Examiner maps the “first wireline interface” to a “means for interfacing computer 3 with interface card 10 in the Figure” in *Brockmann*. If the Examiner insists upon relying on a connection by interface card 10 with the computer 3 of *Brockmann* in order to reject the “first wireline interface” of Claim 1, the Examiner cannot then conclude that it would have been obvious or even technically justifiable to combine *Brockmann* with a reference, such as *Lam*, in such a way that the very connection with the computer 3 that was previously relied upon can no longer even exist. As such, the *Brockmann-Lam* combination is improper.

As the *Brockmann-Lam* combination is improper, as set forth above, and in order to avoid burdening the record, Applicants refrain from setting forth specific patentable distinctions between various dependent claims and the cited references. Applicants reserve the right to raise those distinctions in future responses if necessary. Applicants therefore request reconsideration and allowance of all the remaining pending claims.

**Allowable Subject Matter**

The Examiner states that Claims 7-10, 20-23, and 33-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants decline the Examiner's invitation to amend these claims at this time in view of the amendments and remarks set forth herein.

**CONCLUSION**

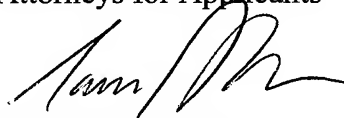
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicants, at the Examiner's convenience at (214) 953-6581.

Although no fees are believed due for this response, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: April 19, 2006

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